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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,996	01/25/2001	Seung-Hyun Nahm	5000-1-156	5422

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EXAMINER

MEHRPOUR, NAGHMEH

ART UNIT PAPER NUMBER

2686

DATE MAILED: 08/11/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

cen

Office Action Summary

Application No.
09/769,996

Applicant(s)

Ulrich Rphs

Examiner
Naghmeh Mehrpour

Art Unit
2686



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Priority

1. Receipt is acknowledged of papers submitted under 35 U.S. C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

- 2 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-3, 9, 13,** are rejected under 35 U.S.C. 102(e) as being anticipated by Parikh (Patent Number 6,408,177).

Regarding **claims 1-2, 9**, Parikh teaches a method for exchanging a message using a short message service (SMS) between a sending party and a receiving party, the method comprising the steps of creating a text message by said sending party in a first portable digital phone (col 3 lines 30-34), creating a plurality of optional response messages associated with said text message

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(col 3 lines 35-47), and forwarding said text message with said optional response messages to said receiving party via said SMS channel (col 3 lines 48-67, col 4 lines 1-2).

Regarding **claims 3, 13**, Parikh teaches a method wherein one of said optional response messages includes a call-back number allowing a response entered by said receiving party to be transmitted back to said sending party (col 4 lines 31-38).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 4-8, 10-12**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Parikh et al. (US patent Number 6,408,177 B1) in view of Coad et al. (US Patent Number 5,966,652).

Regarding **claim 4**, Parikh teaches a method wherein said optional response messages are stored in memory of call management center for the second phone and a provision to said receiving party thereafter (col 7 lines 49-57). Parikh fails to teach that the response messages are stored in the memory of the second phone. However Coad teaches a text Messaging system wherein the response messages are stored in the memory of the second phone. Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to provide above teaching

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of Coad to Parikh, in order to provide transmitted text messages contained text data portions that can be readily extracted by the cellular phone, and providing an easy-to-use visual display of menu option to the user.

Regarding **claims 5, 10**, Parikh teaches a method for exchanging a message using a short message service (SMS) between a sending party and a receiving party (col 3 lines 32-42), the method comprising the steps of detecting a message having a plurality of optional response messages stored in call management center for the receiving party retrieving to display said text message with said optional messages (col 3 lines 35-59), selecting one of said optional response messages by said receiving party forwarding said selected optional response message back to said sending party via said SMS channel (col 3 lines 48-67, col 4 lines 1-3). Parikh fails to teach that the response messages are stored in the memory of the second phone. However Coad teaches a text Messaging system wherein the response messages are stored in the memory of the second phone. Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to provide above teaching of Coad to Parikh, in order to provide transmitted text messages contained text data portions that can be readily extracted by the cellular phone, and providing an easy-to-use visual display of menu option to the user.

Regarding **claim 6**, Parikh teaches a method of wherein said optional response messages comprises a plurality of items identifying different messages to be selected by said receiving party (col 5 lines 11-24).

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Regarding **claim 7**, Parikh teaches a method wherein the optional message are transmitted to the receiving party by the sending party (col 3 lines 60-67, col 4 lines 1-2).

Regarding **claim 8**, Parikh teaches a a method wherein the optional message include a call-back number allowing the selected response entered by the receiving party to be transmitted back to the sending party (col 4 lines 30-38).

Regarding **claim 11**, Parikh teaches a a method further comprising the step of retrieving the text message and the optional messages for a provision to the receiving party (col 3 lines 51-59).

Regarding **claim 12**, Parikh teaches a a method further comprising the step of displaying the retrieved message in a display unit of the second digital terminal (col 1 lines 12-20, col 2 lines 50-53).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Valentine (US Patent 6,112,090) disclose system and method forwarding calling party information

Haumont et al. (US Patent 2001/0019951 A1) disclose voice mail server mobile station and method for voice mail message transmission

Culliss (US Patent Number 2002/0086662 A1) disclose voice message delivery method and system

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7. **Any responses to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications indented for entry)

Or:

(703) 308-6306, (for informal or draft communications, please label

“PROPOSED” or “DRAFT”)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, Va., sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communication from the examiner
should be directed to Melody Mehrpour

NM

August 1, 2003



NGUYEN T. VO
PRIMARY EXAMINER